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20306	7590	11/03/2005	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				CHAU, COREY P
		ART UNIT		PAPER NUMBER
		2644		

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/918,756	COWGILL, CLAYTON NEIL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Corey P. Chau	2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 May 2005.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-5,7-11,13-15,17,18 and 20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5,7-11,13-15,17,18 and 20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7, 13, and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed, does not support the limitations of "the expansion module further includes a battery for providing power to the digital audio player" as claimed in claim 7 now. The specification discloses expansion module would typically contain a battery **or** expansion memory. The specification does not have support for the expansion module includes addition memory that is accessible by the digital audio player when the digital audio player audio signals **and** further includes a battery for providing power to the digital audio player.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent Applicant Publication No. 20010003941 to Sawada et al. (hereafter as Sawada).

5. Regarding Claim 1, Sawada discloses a portable audio device, comprising:

- a digital audio player operable to convert digital signals stored in a memory to audio signals (420);

- b) audio outputs operable to allow a user to hear the audio signals (441,442);

and

- c) an expansion module (400) operable to provide additional capacity to the digital audio player, wherein the expansion module resides on a removable component at a location away from the digital audio player, the removable component (400) being

communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Fig. 8); and

wherein the expansion module includes addition memory that is accessible by the digital audio player when the digital audio player audio signals (Fig. 8).

6. Regarding Claim 2, Sawada discloses the removable component comprises a remote control connected to the player and the audio outputs (400).

7. Regarding Claim 3, Sawada discloses the expansion module resides on the remote control (Fig. 8).

8. Regarding Claim 4, Sawada discloses the expansion module is removable (Fig. 8).

9. Regarding Claim 5, Sawada discloses the expansion module resides on the audio outputs.

10. Regarding Claim 7, as best understood with regards to the 112, 1<sup>st</sup> problem mentioned above, Sawada discloses the expansion module further includes a battery for providing power to the digital audio player (411).

11. Claims 1, 4-5, 7-8, 11, 13, 18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6606506 to Jones.

12. Regarding Claim 1, Jones discloses a portable audio device, comprising:

a) a digital audio player operable to convert digital signals stored in a memory to audio signals (18);

b) audio outputs operable to allow a user to hear the audio signals (12); and

c) an expansion module (abstract; column 3, lines 9-38) operable to provide additional capacity to the digital audio player, wherein the expansion module resides on a removable component at a location away from the digital audio player (Fig. 5), the removable component (Fig. 5) being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Fig. 5); and

wherein the expansion module includes addition memory that is accessible by the digital audio player when the digital audio player audio signals (abstract; column 3, lines 9-38).

13. Regarding Claim 4, Jones discloses the expansion module is removable (abstract; Fig. 5; column 3, lines 9-38).

14. Regarding Claim 5, Jones discloses the expansion module resides on the audio outputs (abstract; Fig 5; column 3, lines 9-38).

15. Regarding Claim 7, as best understood with regards to the 112, 1<sup>st</sup> problem mentioned above, Jones discloses the expansion module further includes a battery for providing power to the digital audio player (Fig. 6).

16. Regarding Claim 8, Jones discloses a portable audio device, comprising:

a) a digital audio player (18) operable to convert digital signals to audio signals (Fig. 5), the player comprising:  
i) a memory (Fig. 3) operable to store digital signals;  
ii) a battery operable to provide power (Fig. 6); and  
iii) a digital to analog converter operable to convert the digital signals to analog audio signals (Fig. 4);

b) a remote control in connection with the player operable to allow a user to operate the player from the remote control (Fig. 5);

c) an expansion module operable to provide additional capacity to the player (abstract; column 3, lines 9-38), wherein the expansion module resides separate from the digital audio player on a removable component the removable component being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Fig. 5);

d) audio outputs operable to allow a user to hear the audio signals (Fig. 5); and wherein the expansion module includes additional memory that is accessible by the digital audio player when the digital audio player is playing audio signals (abstract; column 3, lines 9-38).

17. Regarding Claim 11, Jones discloses the expansion module resides in the audio outputs (abstract; column 3, lines 9-38).

18. Regarding Claim 13, as best understood with regards to the 112, 1<sup>st</sup> problem mentioned above, Jones discloses the expansion module further includes an additional battery for providing power to the digital audio player (Fig. 6).

19. Regarding Claim 18, Jones discloses a portable audio device, comprising:

a) means for converting digital signals stored in a memory to audio signals (Fig. 4);

b) means for allowing a user to hear the audio signals (Fig. 5);

c) means for providing additional memory capacity to the digital audio player, wherein the means for providing additional memory capacity resides at a location away

from the digital audio player on removable component (abstract; column 3, lines 9-38), the removable component being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Fig. 5).

Regarding Claim 20, as best understood with regards to the 112, 1<sup>st</sup> problem mentioned above, Jones discloses including means for providing additional battery capacity to the digital audio player (Fig. 5).

20. Claims 1, 4, 7-8, 13, 18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. 20020084334 to Zhang.

21. Regarding Claim 1, Zhang discloses a portable audio device (Fig. 1), comprising:

a) a digital audio player operable to convert digital signals stored in a memory to audio signals (Fig. 1; page 2, paragraph 0027);  
b) audio outputs operable to allow a user to hear the audio signals (13); and  
c) an expansion module (Fig. 1; page 2, paragraph 0027) operable to provide additional capacity to the digital audio player, wherein the expansion module resides on a removable component at a location away from the digital audio player, the removable component being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Figs. 1 and 4); and  
wherein the expansion module includes addition memory that is accessible by the digital audio player when the digital audio player audio signals (page 2, paragraph 0027).

22. Regarding Claim 4, Zhang discloses the expansion module is removable (Fig. 1).

23. Regarding Claim 7, as best understood with regards to the 112, 1<sup>st</sup> problem mentioned above, Zhang discloses the expansion module further includes a battery for providing power to the digital audio player (Fig. 1).

24. Regarding Claim 8, Zhang discloses a portable audio device, comprising:

a) a digital audio player (Fig. 1) operable to convert digital signals to audio signals, the player comprising:

- i) a memory (206) operable to store digital signals;
- ii) a battery operable to provide power (214); and
- iii) a digital to analog converter operable to convert the digital signals to analog audio signals (Fig. 4);

b) a remote control in connection with the player operable to allow a user to operate the player from the remote control (Fig. 4);

c) an expansion module operable to provide additional capacity to the player (Figs.1 and 4; page 2, paragraph 0027), wherein the expansion module resides separate from the digital audio player on a removable component the removable component being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Fig. 4);

d) audio outputs operable to allow a user to hear the audio signals (Fig. 4); and wherein the expansion module includes additional memory that is accessible by the digital audio player when the digital audio player is playing audio signals (page 2, paragraph 0027).

25. Regarding Claim 13, as best understood with regards to the 112, 1<sup>st</sup> problem mentioned above, Zhang discloses the expansion module further includes an additional battery for providing power to the digital audio player (Fig. 4).

26. Regarding Claim 18, Zhang discloses a portable audio device, comprising:

a) means for converting digital signals stored in a memory to audio signals (Fig. 4);

b) means for allowing a user to hear the audio signals (13);

c) means for providing additional memory capacity to the digital audio player (30), wherein the means for providing additional memory capacity resides at a location away from the digital audio player on removable component (Figs. 1 and 4), the removable component being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Figs. 1 and 4; page 2, paragraph 0027).

27. Regarding Claim 20, as best understood with regards to the 112, 1<sup>st</sup> problem mentioned above, Zhang discloses including means for providing additional battery capacity to the digital audio player (Fig. 4; page 2, paragraph 0027).

28. Claims 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 20020080091 to Acharya et al. (hereafter as Acharya).

29. Regarding Claim 18, Acharya discloses a portable audio device, comprising:

a) means for converting digital signals stored in a memory to audio signals (Figs. 1 and 6);

b) means for allowing a user to hear the audio signals (Figs. 1 and 6);  
c) means for providing additional memory capacity to the digital audio player  
(Figs. 1 and 6; page 3, paragraph 0038), wherein the means for providing additional  
memory capacity resides at a location away from the digital audio player on removable  
component (Fig. 6), the removable component being communicatively coupled to the  
digital audio player when the digital audio player is playing audio signals (Figs. 1 and 6).

30. Regarding Claim 20, as best understood with regards to the 112, 1<sup>st</sup> problem  
mentioned above, Acharya discloses including means for providing additional battery  
capacity to the digital audio player (Fig. 6).

#### ***Claim Rejections - 35 USC § 103***

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set  
forth in section 102 of this title, if the differences between the subject matter sought to be patented and  
the prior art are such that the subject matter as a whole would have been obvious at the time the  
invention was made to a person having ordinary skill in the art to which said subject matter pertains.  
Patentability shall not be negated by the manner in which the invention was made.

32. Claims 1-4, 7-10, 13-15, and 17 are rejected under 35 U.S.C. 103(a) as being  
unpatentable over U.S. Patent Application Publication No. 20020080091 to Acharya.

33. Regarding Claim 1, Acharya discloses a portable audio device, comprising:

a) digital audio player (110), but does not expressly disclose operable to convert  
digital signals stored in a memory to audio signals. However, the Examiner takes  
Official Notice that it is well known in the art that the digital audio player (110) is  
operable to convert digital signals stored in a memory to audio signals in order to allow

a user to play the audio signal on the digital audio player (110). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Acharya to have the digital audio player (110) operable to convert digital signals stored in a memory to audio signals in order to allow the user to play the audio signals on the digital audio player (110).

Therefore Acharya as modified discloses:

b) audio outputs operable to allow a user to hear the audio signals (page 10, paragraph 0111); and

c) an expansion module operable to provide additional capacity to the digital audio player (Figs. 1 and 6), wherein the expansion module resides on a removable component at a location away from the digital audio player (Fig. 6), the removable component (120) being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Fig. 6); and  
wherein the expansion module includes addition memory that is accessible by the digital audio player when the digital audio player audio signals (Figs. 1 and 6).

34. Regarding Claim 2, Acharya as modified discloses the removable component comprises a remote control connected to the player and the audio outputs (120).

35. Regarding Claim 3, Acharya as modified discloses the expansion module resides on the remote control (Figs. 1 and 6).

36. Regarding Claim 4, Acharya as modified discloses the expansion module is removable (Figs. 1 and 6).

37. Regarding Claim 7, as best understood with regards to the 112, 1<sup>st</sup> problem mentioned above, Acharya as modified discloses the expansion module further includes a battery for providing power to the digital audio player (Fig. 6).

38. Regarding Claim 8, Acharya discloses a portable audio device, comprising:  
a) a digital audio player (110) operable to convert digital signals to audio signals (Figs. 1 and 6), the player comprising:

i) a memory (Figs. 1 and 2) operable to store digital signals;  
ii) a battery operable to provide power (i.e. it is inherent the handheld computing system 110 comprise a battery)(page 10, paragraph 0111), but does not expressly disclose iii) a digital to analog converter operable to convert the digital signals to analog audio signals. However, the Examiner takes Official Notice that it is well known the in art that the digital audio player (110) comprises an output jack in order to allow a user to listen to the audio signals, therefore it would have been obvious that the digital audio player (110) comprises a digital to analog converter in order to converter the digital signals in the memory in audio signal which is heard by the user. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Acharya to have an output jack in order to allow a user to listen to the audio signals, therefore it would have been obvious that the digital audio player (110) comprises a digital to analog converter in order to converter the digital signals stored in memory in to audio signal which is heard by the user.

Therefore Acharya as modified discloses:

b) a remote control in connection with the player operable to allow a user to operate the player from the remote control (Figs. 1 and 6);

c) an expansion module operable to provide additional capacity to the player (Figs. 1 and 6; page 3, paragraph 0038), wherein the expansion module resides separate from the digital audio player on a removable component the removable component being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Fig. 6);

d) audio outputs operable to allow a user to hear the audio signals (Figs. 1 and 6); and

wherein the expansion module includes additional memory that is accessible by the digital audio player when the digital audio player is playing audio signals (Figs. 1 and 6; page 3, paragraph 0038).

39. Regarding Claim 9, Acharya as modified discloses the expansion module resides on the remote control (Figs. 1 and 6).

40. Regarding Claim 10, Acharya as modified discloses the expansion module is removable from the remote control (Figs. 1 and 6).

41. Regarding Claim 13, as best understood with regards to the 112, 1<sup>st</sup> problem mentioned above, Acharya as modified discloses the expansion module further includes an additional battery for providing power to the digital audio player (Fig. 6).

42. Regarding Claim 14, Acharya discloses a portable audio device, comprising:

- a) a digital audio player (110), the player comprising:
  - i) a memory operable to store digital signals;

ii) a battery operable to provide power; but does not expressly disclose iii)  
a digital to analog converter operable to convert the digital signals to analog  
audio signals. However, the Examiner takes Official Notice that it is well known  
in art that the digital audio player (110) comprises an output jack in order to  
allow a user to listen to the audio signals, therefore it would have been obvious  
that the digital audio player (110) comprises a digital to analog converter in order  
to convert the digital signals in the memory in audio signal which is heard by  
the user. Therefore it would have been obvious to one having ordinary skill in the  
art at the time the invention was made to modify Acharya to have an output jack  
in order to allow a user to listen to the audio signals, therefore it would have been  
obvious that the digital audio player (110) comprises a digital to analog converter  
in order to convert the digital signals stored in memory into audio signal which  
is heard by the user (i.e. operable to convert digital signals to audio signals).

Therefore Acharya as modified discloses:

- b) a remote control communicatively connected to the player operable to allow a user to operate the player from the remote control (Figs. 1 and 6);
- c) an expansion module resident on the remote control operable to provide additional capacity to the digital audio player (Figs. 1 and 6), and
- d) audio outputs operable to allow a user to hear the audio signals (Figs. 1 and 6).

43. Regarding Claim 15, Acharya as modified discloses the expansion module is removable from the remote control (Figs. 1 and 6)

44. Regarding Claim 17, Acharya as modified discloses the expansion module includes an additional battery for providing power to the digital audio player or includes additional memory for storing digital signals (Figs. 1 and 6).

***Response to Arguments***

45. Applicant's arguments with respect to claims 1-5, 7-11, 13-15, 17-18, and 20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

46. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

47. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corey P. Chau whose telephone number is (571)272-7514. The examiner can normally be reached on Monday - Friday 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chin Vivian can be reached on (571)272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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CPC



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